

### **REMARKS**

Claims 1-7 are now pending in the application. Claims 1, 5 and 6 have been currently amended. Pending claims 1-7 stand rejected under 35 U.S.C. § 102 (e). The forgoing amendments and following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance. An early Notice of Allowance is therefore requested.

#### **I. Claim Objections**

Th Examiner objects to Claim 1 because Applicant uses the word "type" to an otherwise definite phrase. Applicant has deleted the word "type" in Claim 1 as suggested by the Examiner. Thus, this objection is rendered moot.

#### **II. Rejection Of Pending Claims 1-4 and 7 Under Double Patenting**

The Examiner provisionally rejects claims 1-4 and 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending application No. 10/387,739. The Examiner claims that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap the published claims and thus would be rendered obvious.

Applicants respectfully submit that Applicants will not address the issue of a Terminal Disclaimer until subject matter is allowed by the Examiner.

#### **III. Rejection Of Pending Claims 5 and 6 Under 35 U.S.C. §112, Second Paragraph**

The Examiner has rejected claims 5 and 6 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner asserts that claims 5 and 6 contains the trademark/trade name "ETHOMEEN C/15" and "ETHOMEEN S/25", which does

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not comply with 35 U.S.C. § 112, second paragraph. The Examiner states that this is because a trademark or trade name is used to identify a source of goods and not the goods itself.

In order to expedite prosecution of this application, Applicants have amended claim 5 by replacing the phrase “the surfactant is ETHOMEEN C/15, and ETHOMEEN C/15” with the phrase “x and y represent integers which satisfy  $x + y = 5$ , and an alkylamine ethylene oxide adduct represented by the formula (1)...” In addition, Applicants have amended claim 6 by replacing the phrase “the surfactant is ETHOMEEN S/25, and ETHOMEEN S/25” with the phrase “x and y represent integers which satisfy  $x + y = 15$ , and an alkylamine ethylene oxide adduct represented by the formula (1)...” The terms “ETHOMEEN C/15” and “ETHOMEEN S/25” indicate that names of commercially available products produced by Lion Corporation. From an attached copy of the table named “2 Nonionic Surfactants” obtained from the website of Lion Corporation it is clear that in “ETHOMEEN C/15” and “ETHOMEEN S/25”,  $m + n = 5$  (namely,  $x + y = 5$ ) and  $m + n = 15$  (namely,  $x + y = 15$ ), respectively. Therefore, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

#### **IV. Rejection Of Pending Claims 1-7 Under 35 U.S.C. § 102 (e)**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 102 (e) as being anticipated by Koga et al., U.S. Patent Application Serial No. 10/387,739, filed March 13, 2003 and published September 25, 2003 (“Koga”) with a U.S. Publication No. 2003/0179268. Applicants respectfully traverse this rejection.

##### **A. Relevant Law**

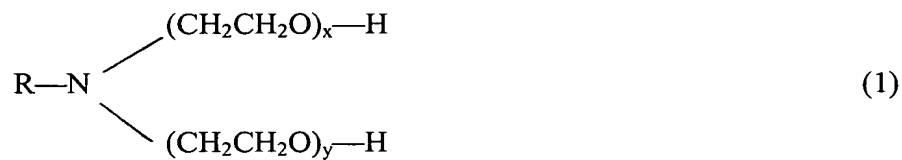
"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d

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1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

**B. Summary of Cited References**

Koga discloses a water based ink for ink-jet recording containing a surfactant represented by the following formula (1) or (2), dipropylene glycol, a coloring agent, and water:



wherein R represents alkyl group and x and y represent integers which satisfy  $x+y=5$  to 15 in the formula (1);



wherein z represents an integer of not more than 9 in the formula (2).

**C. Argument**

The Koga reference is not a prior art reference under 35 U.S.C. §102 (e)(1). As such, the Examiner has improperly rejected claims 1-7 under 35 U.S.C. § 102 (e) as being anticipated by Koga.

35 U.S.C. §102 (e)(1) states the following:

A person shall be entitled to a patent unless—  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent...

Applicants' date of invention is at least August 19, 2002 - the date when its Japanese priority application was filed. This invention date is prior to Koga's US filing date of March 13, 2003.

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As such, Koga does not qualify as prior art and a withdrawal of the Examiner's rejection under 35 U.S.C. §102 (e) based on this reference is appropriate.

**V. Rejection Of Pending Claims 1-6 Under 35 U.S.C. § 102(e)**

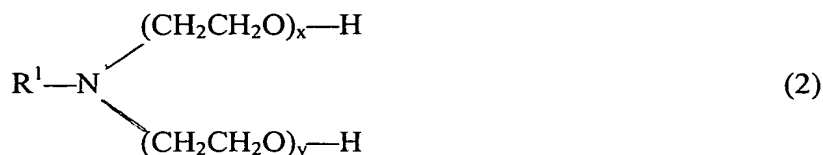
Claims 1-6 stand as rejected under 35 U.S.C. § 102 (e) as being anticipated over Sago et al., U.S. Patent Application Serial No. 10/385,511, filed March 12, 2003 and published September 18, 2003 ("Sago") with a U.S. Publication No. 2003/0174193. Applicants respectfully traverse this rejection.

**A. Relevant Law**

"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

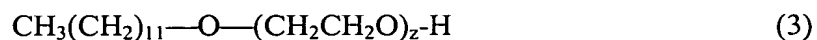
**B. Summary of Cited References**

Sago discloses a water based ink for ink-jet recording containing an amine compound selected from the group consisting of N-n-butylethanolamine, 1,4-bis(3-aminopropyl)piperazine, benzylamine, and an amine compound represented by the following general formulas (2), (3), and (4):

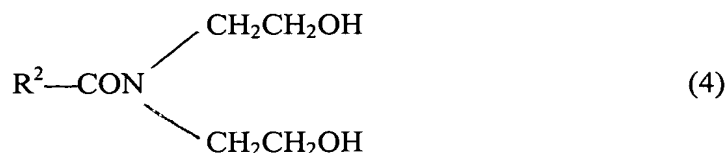


wherein R<sup>1</sup> represents alkyl group and x and y are integers to satisfy x+y=5 to 15 in the formula (2);

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wherein z is an integer of not more than 9 in the formula (3); and



wherein R<sup>2</sup> represents alkyl group in the formula (4), a structural formula, a coloring agent, and water.

### C. Argument

The Sago reference is not a prior art reference under 35 U.S.C. §102 (e)(1). As such, the Examiner has improperly rejected claims 1-6 under 35 U.S.C. § 102 (e) as being anticipated by Sago.

35 U.S.C. §102 (e)(1) states the following:

A person shall be entitled to a patent unless—  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent...

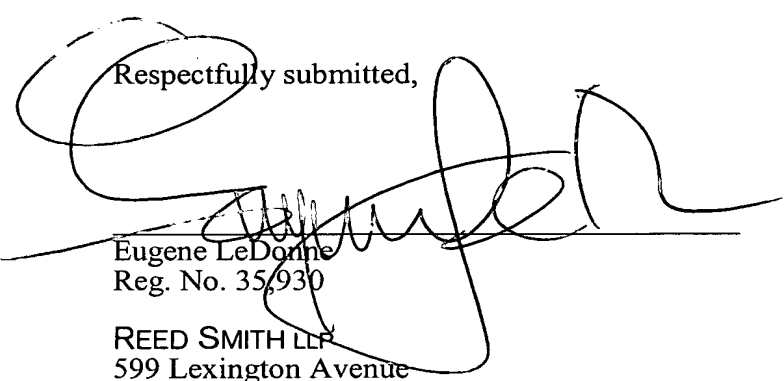
Again, Applicants' date of invention is at least August 19, 2002 - the date when its Japanese priority application was filed. This invention date is prior to Sago's US filing date of September 18, 2004. As such, Sago similarly does not qualify as prior art and a withdrawal of the Examiner's rejection under 35 U.S.C. §102 (e) based on this reference is appropriate.

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**VI. Conclusion**

For the reasons presented above, claims 1-7, all the claims pending in the application, are believed by Applicants to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

Respectfully submitted,



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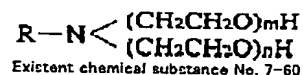
**LION**

LION CORPORATION Chemicals Division

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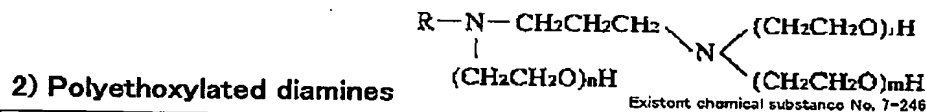
**2 Nonionic surfactants**

**Ethoxylated amines**  
**1) Polyethoxylated amines**



Product	Alkyl group	Mole number of EO (m+n)	Appearance	Active ingredient (%)	Application / Characteristics	Packing (Net: Kg)
ETHOMEEN C/12	Coco	2	Liquid	100	Surface active agents Dispersing agents Emulsifying agents Solubilizing agents Inhibitor oil additives Dyeing assistants	16kg Can
ETHOMEEN C/15		5	Liquid	100		16kg Can
ETHOMEEN C/25		15	Liquid	100		16kg Can
ETHOMEEN T/12	Tallow	2	Paste	100		16kg Can
ETHOMEEN T/15		5	Paste	100		16kg Can 180kg Drum
ETHOMEEN T/25		15	Paste	100		16kg Can 180kg Drum
ETHOMEEN S/12	Soya	2	Liquid	100		16kg Can 180kg Drum
ETHOMEEN S/15		5	Liquid	100		16kg Can 180kg Drum
ETHOMEEN S/25		15	Paste	100		16kg Can 180kg Drum
ETHOMEEN O/12	Oleyl	2	Liquid	100		16kg Can 180kg Drum

ETHOMEEN O/20		10	Liquid	100		180kg Drum
ETHOMEEN HT/12	Hydrogenated tallow	2	Solid	100		16kg Can 180kg Drum
ETHOMEEN HT/14		4	Solid	100		16kg Can 180kg Drum
ETHOMEEN HT/17		7	Solid	100		16kg Can 180kg Drum
ETHOMEEN SAJ 103	---	---	Liquid	30	Textile dyeing assistan	18kg Can
ETHOMEEN SA2Y-103		---	Liquid	30		18kg Can



Product	Alkyl group	Mole number of EO (l+m+n)	Appearance	Active ingre- dient (%)	Application/ Characteristics	Packing (Net: Kg)
ETHODUOMEEN T/13	Tallow	3	Liquid	100	Asphalt additives Dispersing agents	16kg Can 180kg Drum
ETHODUOMEEN T/25		5	Liquid	100	Corrosion inhibitors	15kg Can

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